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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/670,974

09/25/2003

Raymond M. Gatt

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8114

26587

7590

11/22/2005

MCNEES, WALLACE & NURICK LLC
100 PINE STREET
P.O. BOX 1166
HARRISBURG, PA 17108-1166

EXAMINER

HOGUE, GARY CHAPMAN

ART UNIT

PAPER NUMBER

3611

DATE MAILED: 11/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/670,974	Applicant(s) GATT ET AL.	
	Examiner Gary C. Hoge	Art Unit 3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 8 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13 and 20 is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-12 and 14-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Newly submitted claim 8 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the claim does not recite that the attachment means includes protruding edges, and thus it is directed to embodiments that are patentably distinct from the embodiment treated by the Examiner in the previous Office action. (Unlike other deletions in the amendment filed August 31, 2005, the text omitted here is not included in strikethrough font, so it is possible that this omission is merely a typographical error.)

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 8 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the attachment means being provided on two adjacent sides of the frame member (claim 1). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure

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must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, 7, 9 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Erber et al. (5,353,536).

Erber discloses a picture frame assembly comprised of a frame member **8** having a front surface **8a** and a rear surface separated by a perimeter edge **8e**, the frame member adapted to receive and retain a transparent member **12**; a backing member **6** having a display surface **6a** and a rear surface separated by a side edge **6c**, the rear surface having mounting means **6d** for mounting on a mounting surface, the rear surface including means **6d** for spacing the rear surface a predetermined distance from the mounting surface (Fig. 6); and attachment means **8d**, **8f** provided on two adjacent sides of the frame member **8** for removably attaching the frame member and the backing member.

Regarding claim 3, the transparent member disclosed by Erber is plastic (column 7, line 67).

Regarding claim 7, see Figs. 5 and 6 and note that the protruding edges **8d** and **8f** slide relative to the side edge and rear surface of the backing member.

Regarding claim 9, the pressure between the frame member and the backing member constitutes artwork retaining means.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 4-6 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erber et al. (5,353,536) in view of Howell (6,574,896).

Erber discloses the invention substantially as claimed, as set forth above. However, Erber does not disclose a matting. Howell teaches that it was known in the art to apply a matting image directly to a transparent member in a picture frame. It would have been obvious to one having ordinary skill in the art at the time the invention was made to apply the matting image directly to

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the transparent member disclosed by Erber, as taught by Howell, in order to achieve a three-dimensional aesthetic effect.

Regarding claim 6, the matting disclosed by Howell is ink that is adhered to the transparent member by, e.g., silk screening.

7. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erber et al. (5,353,536) in view of Lane (5,419,063).

Erber discloses the invention substantially as claimed, as set forth above. However, Erber does not disclose an elastic band for retaining the sheet 10. Lane teaches that it was known in the art to retain an odd-shaped object in a frame with an elastic band. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the frame disclosed by Erber with an elastic band, as taught by Lane, in order to retain odd-shaped objects in the frame.

8. Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erber et al. (5,353,536) in view of Rousseau et al. (4,991,328).

Erber discloses the invention substantially as claimed, as set forth above. However, the friction that constitutes the artwork retaining means is caused by the interlocking of the frame member with the backing member. Rousseau teaches that it was known in the art to hold frame components together with elastic bands, rather than a mechanical interlock. It would have been obvious to one having ordinary skill in the art at the time the invention was made to hold the frame elements disclosed by Erber together with elastic bands, as taught by Rousseau, in order to facilitate easy separation of the components when desired.

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9. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erber et al. (5,353,536).

Erber discloses the invention substantially as claimed, as set forth above. However, it is not known what material is contemplated for the fabrication of the frame member. Because it is within the level of ordinary skill of a worker in the art to select from among known materials on the basis of their suitability for the fabrication of a given device, and since a person having ordinary skill in the art would know that plastic would be suitable for the fabrication of a frame member, it would have been obvious to one having ordinary skill in the art at the time the invention was made to fabricate the frame member disclosed by Erber from plastic as a matter of choice in design, based on such factors as cost and availability of the materials to the designer.

Regarding claim 15, the mounting means disclosed by Erber is mounting holes.

10. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erber et al. (5,353,536) in view of Howell (6,574,896) as applied to claim 17 above, and further in view of Rousseau et al. (4,991,328).

Erber discloses the invention substantially as claimed, as set forth above. However, the friction that constitutes the artwork retaining means is caused by the interlocking of the frame member with the backing member. Rousseau teaches that it was known in the art to hold frame components together with elastic bands, rather than a mechanical interlock. It would have been obvious to one having ordinary skill in the art at the time the invention was made to hold the frame elements disclosed by Erber together with elastic bands, as taught by Rousseau, in order to facilitate easy separation of the components when desired.

Allowable Subject Matter

11. Claims 13 and 20 are allowed.

Response to Arguments

12. Applicant's arguments filed August 31, 2005 have been fully considered but they are not persuasive.

Regarding the rejection of the claims under 35 U.S.C. 102 as being anticipated by Erber, the way in which Erber anticipates each and every claimed limitation is set forth explicitly above.

Regarding the rejection of the claims under 35 U.S.C. 103, Applicant relies on language that was added in the recent amendment. However, that language does not effect the rejection, as described explicitly above.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

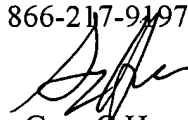
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary C. Hoge whose telephone number is (571) 272-6645. The examiner can normally be reached on 5-4-9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gary C Hoge
Primary Examiner
Art Unit 3611

gch